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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER, and WILL GARDENSWARTZ

Appeal 2006-2100
Application 08/873,974
Technology Center 3600

Decided: January 29, 2008

Before JOSEPH F. RUGGIERO, HOWARD B. BLANKENSHIP, and
DAVID B. WALKER, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal from the Examiner's rejection of claims 50-89, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

We reverse.

I. The Invention

Appellants' invention relates to systems for delivering incentives and related information to consumers via a computer network that links the consumers to network sites provided by product retailers and by manufacturers. (Spec. 1: 6-10.) Claim 50 is illustrative:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

II. The References

The Examiner relies on the following references as evidence of unpatentability:

Sloane

US 5,918,211

Jun. 29, 1999
(filed May 30, 1996)

Narasimhan US 6,237,145 B1

May 22, 2001
(filed Aug. 14, 1996)

III. Procedural Background

In a decision by the Board mailed July 29, 2004, the Board reviewed the Examiner's rejection of claims 50, 51, 60, 61, 70, 71, 80, and 81 under 35 U.S.C. § 102(e) as being anticipated by Sloane, and the rejection of claims 52-59, 62-69, 72-79, and 82-89 under 35 U.S.C. § 103 as being unpatentable over Sloane in view of Narasimhan. The rejection of the claims under 35 U.S.C. § 102(e) was affirmed. The rejection of claims 52, 53, 55-59, 62, 72, and 82 under 35 U.S.C. § 103 was affirmed, *pro forma*, because no substantive arguments on Appellants' part were found in response to the rejection. Although there were affirmed rejections, the proceeding was remanded to the Examiner to either withdraw the rejection of claims 54, 63-69, 73-79, and 83-89 under 35 U.S.C. § 103, or reopen prosecution, because the rejection was found to be an improper new ground of rejection.

In a decision on Request for Rehearing (mailed Sep. 30, 2004), the Board noted the difficulty in determining the arguments that had been presented in opposition to the rejections, as Appellants had filed various briefs, and supplemental briefs, which attempted to incorporate by reference earlier briefs. The Request was denied to the extent of making any modification in the earlier decision of July 29, 2004.

Appellants filed an appeal to the U.S. Court of Appeals for the Federal Circuit on November 23, 2004. The Court remanded the case to the USPTO (Mar. 9, 2005) upon consideration of Appellants' unopposed motion. The Board's decision was not a final decision ripe for judicial review. *See* 37 C.F.R. § 41.50 (e) (effective Sep. 13, 2004) ("Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.").

In due course, the Examiner mailed a non-final rejection (Jul. 12, 2005) that set forth a rejection of claims 63, 73, and 83 under 35 U.S.C. § 103(a) as being unpatentable over Sloane, and a rejection of claims 54, 64-69, 74-79, and 84-89 under 35 U.S.C. § 103(a) as being unpatentable over Sloane and Narasimhan.

Appellants in response filed the Appeal Brief¹ (Dec. 12, 2005; styled as a reply brief), to which the Examiner responded in turn by the (most recent) Examiner's Answer mailed March 13, 2006. Finally, Appellants filed the Reply Brief in response, on March 17, 2006.

The Examiner, in the most recent Answer, repeats the rejections set forth in the Non-Final rejection of July 12, 2005. In the Examiner's view, the instant appeal does not involve claims 50-53, 60-62, 70-72, and 80-82, as

¹ Appellants submit that we should review an earlier rejection under 35 U.S.C. § 112, first paragraph, that was withdrawn by the Examiner and is thus not before us. We decline, as did the earlier Board panel, to review a rejection that no longer exists and which represents no current controversy.

the rejection of those claims was earlier sustained by the Board. The rejections are not repeated in the most recent Answer.

IV. Representative Claims 50, 54

Claim 54, rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloane and Narasimhan, depends from claim 50. To understand claim 54 thus requires that we understand the limitations of the base claim that claim 54 incorporates by reference. Our review of the rejection of claim 54 also requires that we understand the rejection applied against claim 50 (as being anticipated by Sloane), since claim 54 is rejected over the combined teachings of Sloane and Narasimhan.

Appellants have presented arguments in the Appeal Brief that convince us of error in the rejection applied against representative claim 54, and against all the independent claims rejected under § 102(e) over Sloane. We would normally not re-visit a decision by an earlier panel of the Board. We will do so, however, in view of the particular circumstances of this case. First, as we have noted, we must understand the rejection applied against claim 50 to understand the rejection applied against claim 54. Further, as the earlier panel noted, the arguments presented to that panel were difficult to ascertain because of the multiple briefs and the arguments scattered throughout.² Still further, we are not reversing the decision of the earlier

² Appellants' current Appeal Brief does not purport to incorporate other papers by reference, nor should it. *See* 37 C.F.R. § 41.37 ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to

panel because, as we have noted, the decision was not a final decision of the Board. The Board was free to reconsider the decision in the event that the application returned to the Board's jurisdiction. Finally, the record before this panel has been supplemented by Appellants' current briefs, and thus constitutes a record different from that upon which the earlier panel based its determinations. If the case had been returned to the earlier panel, that panel might well have decided that the record then before the panel required that the earlier-affirmed rejections be reconsidered.

V. Section 102 rejection over Sloane

The Examiner applies a rejection against all the independent claims (50, 60, 70, and 80) under 35 U.S.C. § 102(e) as being anticipated by Sloane at pages 7 and 8 of the Non-Final Rejection mailed September 23, 2002, repeated at pages 3 and 4 of the Answer mailed March 11, 2003 ("03 Answer").

Sloane describes a system in which a consumer receives a portable bar code scanner (20; Fig. 2a) when entering a retail establishment. Sloane col. 5, ll. 29-51. When the consumer scans a product, display 34 (Fig. 2a) will show the product's price, in addition to showing any promotional information available for that product or a related product. Col. 6, ll. 20-25. The bar code scanner 20, in conjunction with retailer computer/controller 12 (e.g., Figs. 5 and 6), will, *inter alia*, maintain a running total of the

§ 41.41 will be refused consideration by the Board, unless good cause is shown.").

purchases made by the user, and enable the user to view the current savings on the shopping trip. Col. 6, l. 64 - col. 7, l. 3.

As set forth in the '03 Answer (at 4), the Examiner finds that the retailer computer/controller of Sloane is “analogous to” the cooperative network site and the sender (16; Fig. 3b) of Sloane is “analogous to” the manufacturer. The Examiner reads the claimed “consumer computer” on the portable bar code scanning device of Sloane. The “wherein” clause of claim 50 is deemed to be met by the description at column 7, line 65 through column 8, line 7, and at column 8, lines 44 through 48.

Claim 50 recites, *inter alia*, wherein “said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request *made over said communication network from one of said manufacturer network site and retailer network site*” (emphasis added). The statement of the rejection ('03 Answer 4) ends with “in response to a consumer request...,” and does not indicate how the rest of claim 50 might be met by Sloane.

However, the '03 Answer appears to offer an explanation of how the language is met, in the “Response to Argument” section.

[T]he cooperative network site is represented in Col. 7, lines 15-22 by the on-line computer network (LAN OR WAN). This computer network acts as the cooperative network site since this addition allows the manufacturer computer system to communicate with the retailer computer system. Also, Sloane shows that a consumer request can be incorporated into the system in Col. 2, lines 17-21. In this case, the consumer

requests a promotion/coupon through an on-line computer network. Also col. 7, lines 4-15 show that when a consumer selects an item (analogous to the consumer request), the sender of the promotional information sends the information to the retailer computer. In this case, the consumer's request triggers the transmittal of the promotional information from the manufacturer's system to the retailer's system.

('03 Answer 11-12.)

Sloane provides:

Other methods of issuing electronic coupons or promotions to the consumer's frequent shopper electronic account includes consumer requested promotion/coupons through the use of their home computer and an online computer network, such as, for example, the internet.

Sloane col. 2, ll. 17-21.

The text at column 2, lines 17 through 21 of Sloane might show that a consumer request "can be" incorporated into the inventive system of Sloane, but that seems to relate to an inquiry into obviousness. The rejection, however, is under § 102 for anticipation. The "other methods" described by Sloane in column 2 are in the context of describing the prior art in relation to Sloane; i.e., the text at column 1, line 15 through column 2, line 49 describes "The Prior Art."

Sloane further provides:

FIG. 3a shows the first step of the method according to the invention. A retailer 14 designates items that are on sale, or offered with some other consumer promotion or message, and instructs the retailer computer/controller 12 to offer these promotions to the consumer when one of the subject items or

related items are selected (i.e., scanned) by the consumer. FIG. 3b shows an alternative first step to the method where the sender of promotion information 16 can be someone other than the retailer, such as, for example, the product manufacturer. The sender of promotion information 16 sends the information to the retailer computer/controller 12 via communication line 200.

Sloane col. 7, ll. 4-15.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

We do not find any support in Sloane for the Examiner’s finding that the sender of the promotional information sends the information to the retailer computer when the consumer selects an item, or that the consumer’s request triggers the transmittal of the promotional information from the manufacturer’s system (16; Fig. 3b) to the retailer’s system. For example, Sloane’s drawings indicate information transfer between the portable bar code scanning device and the retailer computer/controller 12 (e.g., Figs. 5 and 6), which is separate from the reception by the retailer computer of promotion information by sender 16 (Fig. 3b). “Retailer computer/controller 12 is programmed to receive and store the promotional information sent by

retailer 14 or sender 16, and can therefore offer the promotions at the appropriate time and to the appropriate consumer.” Sloane col. 7, ll. 22-26.

Nor do we find that Sloane inherently describes the material that the rejection attributes to the reference.

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). In Sloane, information is *not necessarily* transmitted to the consumer in response to a consumer request made over the communication network from the retailer network site, because retailer computer/controller 12 can already possess the information received from sender (or manufacturer) 16 when the consumer selects an item, consistent with the express disclosure.

VI. The Rejections

For the foregoing reasons in Section V, Sloane fails to provide sufficient support for the Examiner’s finding of anticipation with respect to independent claim 50. Each of the other independent claims (60, 70, and 80), rejected under § 102(e) over Sloane, contains substantially the same limitations of claim 50 that we consider to be not met by the reference. Because the remaining rejections do not remedy the basic deficiency in the

rejection applied against the independent claims, we cannot sustain any rejection on appeal.

CONCLUSION

The Examiner's rejections of claims 50-89 over the applied prior art are reversed.

REVERSED

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